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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,109	08/08/2000	Gabriel Vogeli		4465

7590 04/07/2004

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6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402

EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,109

Applicant(s)

VOGELI ET AL.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 29-54 is/are pending in the application.
- 4a) Of the above claim(s) 30-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment filed 5 January 2004 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Applicant's arguments filed 5 January 2004, have been fully considered but they are not found persuasive.

Claim Rejections - 35 USC § 101

4. Claims 1-5, and 29 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a substantial asserted utility or a well established utility.

The reasons for the rejection has been set forth in the previous office action.

Applicants argue that because the claimed CON167 is a G-protein coupled receptor that it has utility because other G-protein coupled receptors have utility. However, the claimed polypeptide must have utility and the orphan receptors do not have utility as discussed previously. The therapeutic agents useful for other G-protein coupled receptors are specific for those receptors are not applicable to CON167 which is an orphan receptor. There is no nexus from the other G-protein receptor or disease

treatment to the claimed orphan receptor because the function of the orphan receptor is not known.

Applicants arguments directed to pages 35-47 of the specification to identify ligands, protein binding partners and modulators is not found persuasive. The search for these compounds requires the identification of the known ligand and function of the CON167 which was unknown at the time of filing of the application because it is an orphan receptor.

Applicants argue that issued US patents are evidence of an art recognized utility for G-protein coupled receptors whose natural ligand is unknown. However, each application must be considered on its own merits. Utility guidelines were published in the OG to discuss the importance of utility in patent applications.

The orphan polypeptide lacks substantial utility because further research to identify or reasonably confirm a "real world" context of use is required. Thus, the asserted utility lacks substantial and specific utility because further research to identify or reasonably confirm a "real world" context of use is required. *Brenner V. Manson* 383 U.S. 519, 535-536, 148 USPQ 689, 696 (1966) stated that "Congress intended that no patents be granted on an chemical compound whose sole "utility" consists of its potential role as an object of use-testing ... a patent is not a hunting license." *Brenner* further states that "It is not a reward for the search, but compensation for its successful conclusion." Any utility of the nucleic acid encoding the protein or other specific asserted utility is directly dependent on the function of the protein. A circular assertion of utility is created where the utility of the protein is needed to break out the circular assertion of

utility. The polypeptides do not substantial utility because the skilled artisan would need to prepare, isolate, and analyze the protein in order to determine its functional nexus with human therapeutics. Therefore, the invention is not in readily available form. Instead, further experimentation of the protein itself would be required before it could be used.

5. Claims 1-5 and 29 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 112

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recite different domains of SEQ ID NO:2 which are not clearly set forth. It not clear what is the metes and bounds of the claimed polypeptide domains because transmembrane domains are relative regions set forth with various parameters which are not set forth in the claims. Depending on the parameters for example one method of measuring hydrophathy may vary from others or even within the same measuring system.

Priority

7. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the continuing application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-5 and 29 of this application.

Applicants argue that effective filing date of the application be recognized because 35 USC 112 rejections does not apply. Until the rejection has been overcome the priority is denied.

Claim Rejections - 35 USC § 102

8. Claims 1, 3-5, and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Stryer et al.(US 2002/0132273).

The reasons for the rejection has been set forth in the previous office action.

Applicants argue that Stryer reference does not qualify as prior art because the effective filing date of the application predates the reference. However, However, the continuing application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 1-5 and 29 of this application.

9. No claims are allowed.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1646

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

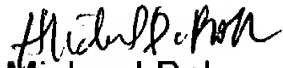
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak, whose telephone number is (571) 272-0879. The examiner can normally be reached on Monday through Friday from 8:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 272-0871.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Michael Pak
Primary Patent Examiner
Art Unit 1646
29 March 2004